



## UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,631	04/10/2001	David R. Sibley	NIH047.1CP1C1	7640
20995	7590	12/09/2003	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ALLEN, MARIANNE P	
			ART UNIT	PAPER NUMBER
			1691	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/829,831

**Applicant(s)**

SIBLEY ET AL.

**Examiner**

Marianne P. Allen

**Art Unit**

1631

**Period for Reply** - The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  
 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  
 If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  
 Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.  
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 17,20 and 22-28 is/are rejected.  
 7) ☒ Claim(s) 18,19 and 21 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.  
 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_  
 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other:

Application/Control Number: 09/829,631

Page 2

Art Unit: 1631

### DETAILED ACTION

Applicant's arguments filed 6/23/03 have been fully considered but they are not persuasive.

Claims 17-28 are under consideration by the examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Oath/Declaration*

It is maintained that in view of originally filed claims 1-16 in this application, this application remains a continuation-in-part application and a new oath is required as set forth in the prior Office action. The status as a continuation-in-part application will not change even if the presently pending or any future claims have basis in the parent applications and are granted benefit of that priority date. Once again, as filed, this application constituted a continuation-in-part application. Applicant's arguments on this point are not germane nor do they dispute that originally filed claims 1-16 were not supported by the parent application.

### *Priority*

Applicant is requested to update the status of all applications referenced throughout the specification.

### *Claim Rejections - 35 USC § 112*

Claims 17, 20, and 22-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Application/Control Number: 09/829,631

Page 3

Art Unit: 1631

For the purposes of discussing the new matter rejection, basis for the present claims will be considered with respect to basis in WO 94/10310. All page references will be with respect to this document.

Claim 17, part (c) is directed to nucleotide sequences that hybridize under particular conditions and encode a serotonin receptor protein St-B17.

Example 9 at page 22 discloses using the rat St-B17 serotonin receptor sequence fragments and conditions named in part (c) to clone the human sequence from a particular human genomic library (Stratagene # 946205). There is no contemplation of generic St-B17 sequences encoding receptors from other species that would hybridize to the recited restriction fragments under the recited conditions. This specific example is not considered to demonstrate contemplation of the generic invention now claimed.

None of the portions of the specification pointed to by applicant show contemplation for the embodiments encompassed by part (c).

***Claim Rejections - 35 USC § 102***

Claims 17, 20, and 22-28 are rejected under 35 U.S.C. 102(b) as being anticipated by either of Sibley et al. (WO 94/10310) or Sibley et al. (EP 0 558,912 B1).

As presently written, these claims are entitled to benefit of the instant filing date of 4/10/01 and both Sibley et al. (WO 94/10310) and Sibley et al. (EP 0 558,912 B1) are valid prior art under 35 U.S.C. 102(b). Claim 17, part (c) is not supported by the instant application nor any of the priority documents and is properly denied benefit.

Both Sibley et al. (WO 94/10310) and Sibley et al. (EP 0 558,912 B1) disclose cloning and expression of the rat and human St-B17 serotonin receptor. Vectors and host cells are

Application/Control Number: 09/829,631  
Art Unit: 1631

Page 4

disclosed. The sequences disclosed would meet the limitations of part (c) of claim 17. See abstract, claims, and figures. In particular, claim 1 part (c) of Sibley et al. (EP 0 558,912 B1) reflects the same language as instant claim 17, part (c). It is noted that the instant application does not claim priority to this document and what is contemplated in this European patent is not found in the instant application, parent application 08/428,242, PCT/US93/10296 nor parent application 07/970,338.

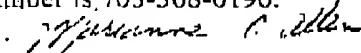
### **Conclusion**

Claims 18, 19, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631

mpa